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OFFICE OF PETITIONS

In re Application

A. Maxwell Eliscu et al.

Application No. 09/667,391

Filed: September 20, 2000

Attorney Docket No. 046983-0103

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: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
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This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705 filed January 15, 2010. Applicant requests that the initial determination of Patent Term Adjustment of 1436 days under 35 U.S.C. 154(b) be corrected to 2136 days, in part on the basis that the Office will take in excess of three years to issue this patent and in light of the court decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand seven hundred ninety-nine (**1799**) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On October 22, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is one thousand four hundred thirty-six days. Applicants submit the instant renewed application for patent term adjustment requesting that the initial determination of Patent Term Adjustment of 2136 days under 35 U.S.C. 154(b) be further adjusted under 37 CFR 1.702.¹

The Office initially determined a patent term adjustment of one thousand four hundred thirty-six (1436) days based on an adjustment for PTO delay of one thousand seven hundred sixty-nine (1769) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and (a)(2) reduced by applicants' delay of three hundred thirty-three (333) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). Applicant contends however that the patent issuing from this application is entitled to more days of patent term adjustment based on Office delay.

Applicants submit evidence to show that the holding of abandonment for failure to timely respond to the non-Final Office Action was withdrawn based on their showing that a response had been filed on April 14, 2004 one day past the three month period within which the response was due. In support of a showing that the response was received April 14, 2004, applicants submitted a copy of their date-stamped postcard and a certificate of mail.

¹

PALM records indicate that the Issue Fee was received in the Office on January 15, 2010.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

A review of the application history reveals that no response to the non-Final Office Action mailed January 13, 2004 was considered timely filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed September 30, 2004. In response, on October 12, 2004 and on September 1, 2005 applicants filed a grantable petition to withdraw the holding of abandonment. It is specifically noted that the initial petition to withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed December 19, 2005, the petition was granted on the basis that applicants had shown that a proper response was filed on April 14, 2004 with a USPTO date stamped post card receipt.

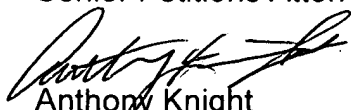
Thus, one (1) day of applicant delay should be deducted pursuant to 37 CFR 1.704(b) and not one hundred eighty-two (182) days. Further, four months from the filing of the response, August 14, 2004 to the mailing of the Final Office Action on April 6, 2006, six hundred (600) days should be accorded as PTO delay pursuant to 1.703(a)(2).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is one thousand seven hundred ninety-nine (1799) (784 plus 600 plus 567 attributable to examination delay minus 1 plus 32 plus 26 plus 7 plus 86 applicant delay) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) with the instant renewed application. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Patricia Faison-Ball, Senior Petitions Attorney, at (571) 272-3212.


Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Revised PALM Screen.

PTA Calculations for Application: 09/667391

Application Filing Date:	09/20/2000	PTO Delay (PTO):	1769
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	333
Post-Issue Petitions:	0	Total PTA (days):	1799
PTO Delay Adjustment:	363		

File Contents History

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90	10/21/2009	ISSUE REVISION COMPLETED			
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87	10/21/2009	EXAMINER'S AMENDMENT COMMUNICATION			
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78	12/12/2008	APPEAL AWAITING BPAI DOCKETING			
77	10/06/2008	APPEAL READY FOR BPAI REVIEW			
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75	05/22/2008	MAIL EXAMINER'S ANSWER			
74	05/22/2008	EXAMINER'S ANSWER TO APPEAL BRIEF			
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71	05/06/2008	APPEAL BRIEF FILED			
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69	03/31/2008	PRE-APPEALS CONFERENCE DECISION - PROCEED TO BPAI			
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51	10/12/2006	NON-FINAL REJECTION			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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